

Notice of Allowability

Application No.

09/890,889

Examiner

Michael J. Feely

Applicant(s)

HOFMANN ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to response filed 9/12/05.
2. ☒ The allowed claim(s) is/are 12-23 and 25-31.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 0905.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Pending Claims

Claims 12-23 and 25-31 are pending.

Terminal Disclaimer

1. The terminal disclaimer filed on September 12 and 21, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of:

- US Pat. No. 6,867,162 (Application Serial No. 10/717,094);
- US Pat. No. 6,852,663 (Application Serial No. 10/138,080);
- US Pat. No. 6,586,566 (Application Serial No. 09/890,995);
- US Pat. No. 6,835,687 (Application Serial No. 10/257,706); and
- US Pat. No. 6,780,813 (Application Serial No. 10/148,555),

have been reviewed and is accepted. The terminal disclaimers have been recorded.

Response to Arguments

2. Applicant's arguments, see pages 6-8 of the response, filed September 12, 2005, with respect to the ODP rejections over US Serial No. 10/493,608 and US Pat No. 6,764,978 have been fully considered and are persuasive. The ODP rejections over these references have been withdrawn because these references have no common inventorship or ownership with the instant invention.

Art Unit: 1712

Allowable Subject Matter

3. Claims 12-23 and 25-31 are allowed.

4. The following is an examiner's statement of reasons for allowance:

Hofmann et al. (WO 99/46042 & US equivalent 6,291,388) and Hofmann et al. (WO 99/19063 & US equivalent 6,323,375) are the closest prior art. They disclose similar DMC catalyst to that of instant claims 12 and 19; however, they provide no motivation to include at least one bile acid or its salt, ester or amide in combination with at least one double-metal cyanide compound and at least one organic complex ligand that is not a bile acid, bile acid salt, bile acid ester or bile acid amide.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

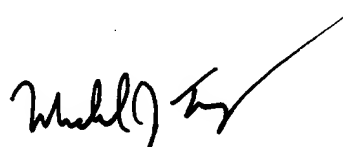
Art Unit: 1712

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Michael J. Feely", with a long, sweeping horizontal line extending to the right.

Michael J. Feely
Primary Examiner
Art Unit 1712

September 28, 2005